

Application No.: 10/686,517

Docket No.: 33396-198024

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Amar Lulla

Art Unit: 1618

Application No: 10/686,517

Examiner: M. P. Young

Confirmation No: 4905

Filed: October 16, 2003

Atty. Docket No: 33396-198024

For: TOPICAL SPRAY COMPOSITION

Customer No:

26694

PATENT TRADEMARK OFFICE

**STATEMENT OF FACTS TO ACCOMPANY**  
**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT**  
**ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

I, Dr. Alka Mehta, hereby declare the following:

1. I am an official, In-house Patent Counsel of CIPLA Limited (Cipla), and authorized to provide prosecution instructions to Venable LLP in the above referenced application on behalf of U&I Pharmaceuticals, the assignee of the application.
2. I understand that no response was filed to an Office Action issued by the USPTO on June 9, 2008. As a result, the USPTO issued a Notice of Abandonment on March 4, 2009.
3. The Office Action and deadlines for response were unknown to me or any other individual with direct involvement in the prosecution of the referenced application and authorized to instruct the Assignee's representatives, Venable LLP, to take action in response to the Office Action until the third week of May 2010.
4. It was not the intent of CIPLA Limited to delay response to the Office Action or to allow the application to become abandoned. A detailed explanation of the cause of the unintentional delay follows.

5. I understand from Venable that, on July 3, 2008, Venable transmitted a letter by facsimile to the attention of Geena Malhotra and Amar Lulla at CIPLA notifying them of the September 9, 2008 deadline for responding to the Office Action. According to Venable, a copy of the Office Action was included in the transmission. Since the above mentioned individuals and the Patent Department are located at different locations, I believe that there must have been some confusion in directing the facsimile to the Patent Department. As a result of this, the communications never reached me or the Patent Department and so we were unaware of any pending office action.
6. I understand from Venable that, on September 9, 2008 and October 20, 2008, Venable transmitted reminders by facsimile to the attention of Geena Malhotra and Amar Lulla at CIPLA. According to them, these reminders included notifications of extended deadlines, and the final deadline of December 9, 2008. As explained above, these notification never reached me or the Patent Department and I was totally unaware that such reminders were transmitted to the above named individuals until Venable informed me after we discovered the application was abandoned.
7. I understand from Venable that, on June 3, 2009, Venable transmitted a letter by facsimile to the attention of Geena Malhotra and Amar Lulla at CIPLA, to report the Notice of Abandonment issued by the USPTO on March 4, 2009. According to Venable, a copy of the Notice of Abandonment was included in the transmission. This letter also never reached me or the Patent Department, like the other letters.
8. According to Venable, all the above letters were sent to fax number 011 91 22 2307 0013. The Patent Department does not receive facsimile transmissions at this number. This number is associated with a fax machine located in Mumbai Central separate from the Patent Department. Transmissions received at this location are normally processed by non-technical administrative staff not associated with the Patent Department.
9. Between May 18, 2010 and May 20, 2010, Mr. Kusaji Parab at CIPLA Limited discovered that the application was abandoned during a status check of the application in the USPTO PAIR database. This was the first time that an authorized individual at CIPLA Limited directly involved with the application became aware of the abandonment. I notified Ms. Aarti Deodhar, who

contacted Venable LLP on May 24, 2010 to inquire about the status and to whether the application could be revived at this time.

10. On June 16, 2010, I again indicated to Venable that we became aware that the application was abandoned and desired to revive the application; and on June 21, 2010 instructed Venable LLP to forward an additional copy of the pending office action and to prepare a petition to revive the application. Since then, I have collaborated with Venable LLP to prepare and finalize the response to the pending Office Action and the petition to revive the application and this declaration.
11. During the period between June 9, 2008 and the day the abandonment was discovered, CIPLA Limited did not check the status of the application because we were unaware that any further office action had been issued further to the office action replied on March 28, 2008. Further, the need to check the status for the application arose because we were planning some studies for one of our European patent applications relating to a similar dosage form and we wanted to check if any of these studies could be useful for the US application in question. That is the reason why we decided to check the US PAIR site and also our files for the status of the application. This is when we discovered for the first time that the application was abandoned due to failure to respond to the office action.
12. Neither I, nor anyone else authorized to issue instructions on behalf of CIPLA Limited or, to my knowledge, U&I Pharmaceuticals, instructed Venable to abandon the application or allow the application to become abandoned at any time after the Office Action was mailed on June 9, 2008.
13. The entire delay in filing the required reply from the due date for the required reply until the date this petition was filed was unintentional.

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14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

*A. G. Mehta*

**Dr. Alka Mehta**

*July 23, 2010*

Date